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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/489,576	01/21/2000	William J. Baer	STL000013US1	6006
23373	7590	04/07/2006	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			NGUYEN BA, PAUL H	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/17/2006 has been entered.
2. Claims 1-51 are currently pending. Claims 1, 6, 16, 21, 31, and 36 are independent claims.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGraw-Hill Primis Custom Publishing ("McGraw") ([www.mhhe.com/primis](http://www.mhhe.com/primis)), archived

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circa 1998, via the Wayback Machine ([www.archive.org](http://www.archive.org)), in view of Helmick et al.

("Helmick"), U.S. Patent No. 6,470,171.

**Regarding independent claim 1:**

McGraw teaches a method for creating customized published textbooks (*compare with "books"*) corresponding to the each particular user's needs, teaching technique, style, content, and organization (see all of pg. 1).

*A method for adding content to a first content object stored as a first plurality of content entities in a data repository, the data repository containing a second plurality of content entities of a second content object, each of the content entities having an identifier, comprising:*

- *wherein the first list of content entity identifiers comprises a plurality of content entity identifiers, and*
- *wherein the location determined by the user is between the plurality of content entity identifiers.*

McGraw teaches a custom publishing database (*compare with "data repository"*) that contains a collection of modular, stand-alone text files (*compare with "second plurality of content entities of a second hierarchically structured content object"*) (see pg. 3, paragraphs 1-3 → includes textbooks, supplements, journals, magazine articles, lab manuals, case studies, literary works, and historical documents each structured such that the content entities rank or grade in a subordinate manner in a "hierarchy;" see also pgs. 5-12 → i.e. discipline, volume, chapter, section, etc.) that can be mixed and matched ***in any order*** (*compare with "at a location determined by user"*) and seamlessly arranged to create a custom book (*compare with "first hierarchically*

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structured content object”) consisting of the selected modular text files (*compare with* “first plurality of content entities”) (see pg. 3, bulleted features).

Each of the “content entities” of the first and second object lists has corresponding identifiers (see pgs. 5-9, and 12 → each content identity is identified by a unique title or name, a unique URL, and a unique Item Identifier number). A user can determine the location of identifiers simply by adding said identifiers in any order that the user prefers. In other words, if user wanted a particular identifier in the second position, user would add said identifier second. As far as resequencing content, a user is free to resequence the identifiers at a later stage. This process would thus 'add' the identifier to another location of the first list, while resequencing all the other identifiers in the list accordingly. Either method would preclude the broad claim language as set forth.

McGraw does not explicitly teach:

- *such that adding the content entity identifier of one of the second plurality of content entities to the first list adds the identified content entity to the first content object.*

However, McGraw teaches an “Add” hyperlink corresponding to each second object identifier (see pgs. 7, 9, and 12) for the purpose of adding the content entities of a second object to a first object “in any order” (see pg. 3). McGraw further teaches a “Review” hyperlink for the purpose of reviewing the contents of the first object of the custom publishing process.

It was commonly known to those of ordinary skill in the art and would have been obvious at the time the invention was made to a person having ordinary skill in the art to define the first object by a first list of content entity identifiers organized as an outline of containers such that adding the content entity identifier of one of the second plurality of content entities to the first list outline adds the identified content entity to the first content object at a location determined by a user for the express motivational purpose of an efficient and direct means for adding (i.e., mixing or matching) the content entities of a second object to a first object "in any order" to create a customized text book from user selected portions of other texts or materials (i.e., objects).

Moreover, Helmick also teaches an on-line system for display of educational materials wherein a user can use a course manager screen in order to build an electronic syllabus (see Figs. 3V-3X). Fig. 3X specifically teaches an add content screen used to add or modify content for particular identified units of a course and thus build a syllabus in a tree/outline form for said course (see col. 25 lines 8-58).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teaching of McGraw with the teachings of Helmick to include defining the first object by a first list of content entity identifiers organized as an outline of containers such that adding the content entity identifier of one of the second plurality of content entities to the first list outline adds the identified content entity to the first content object at a location determined by a user for the

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motivational purpose of an efficient and streamlined method of building a custom hierarchical outline compilation of educational materials.

**With respect to independent claim 6**, please refer to the rationale relied upon to reject independent claim 1. McGraw teaches the further limitations of a hierarchically structured outline as set forth in claim 6.

Specifically, McGraw teaches a custom publishing database (*compare with* “data repository”) that contains a collection of modular, stand-alone text files (*compare with* “second plurality of content entities of a second hierarchically structured content object”) (see pg. 3, paragraphs 1-3 → includes textbooks, supplements, journals, magazine articles, lab manuals, case studies, literary works, and historical documents each structured such that the content entities rank or grade in a subordinate manner in a “hierarchy;” see also pgs. 5-12 → i.e. discipline, volume, chapter, section, etc.) that can be mixed and matched ***in any order*** (*compare with* “at a location determined by user”) and seamlessly arranged to create a custom book (*compare with* “first hierarchically structured content object”) consisting of the selected modular text files (*compare with* “first plurality of content entities”) (see pg. 3, bulleted features).

**Independent claims 16 and 31**, incorporate substantially similar subject matter as independent claim 1, and are rejected along the same rationale.

**Independent claims 21 and 36**, incorporate substantially similar subject matter as independent claim 6, and are rejected along the same rationale.

**Regarding claims 2, 7, 17, 22, 32, 37**, McGraw further teaches defining the second object by a second outline of containers (pgs. 3, 7, 9, and 12 → the available textbooks are defined in hierarchical outline form (collection of modular text files that can be mixed and matched) → book containers, chapter containers, etc.) or list of content entity identifiers (see pgs. 5-9, and 12 → each content identity is identified by a unique title or name, a unique URL, and a unique Item Identifier number).

**Regarding claims 3, 8, 18, 23, 33, 38**, McGraw further teaches the method, system, and a program storage device readable by a machine wherein adding an entity identifier from the second list or second outline container to the first list adds the identified content entity to the first object. (pgs. 7, 9, 12 → the "Add" hyperlink adds the second list or outline to the customized textbook, as discussed above).

**Regarding claims 4, 11, 19, 26, 34, 41, 49, 50, 51**, McGraw teaches wherein the first object is a book, and the content entities are at least one of a volume, a chapter, and a section (see pg. 3, paragraphs 1-3 → includes textbooks, supplements, journals, magazine articles, lab manuals, case studies, literary works, and historical documents each structured such that the content entities rank or grade in a subordinate



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manner in a "hierarchy;" see also pgs. 5-12 → i.e. discipline, volume, chapter; section, etc.).

**Regarding claims 5, 13, 14, 20, 28, 29, 35, 43, 44,** McGraw further teaches a *user interface communicating with the data repository* (pgs. 5-12 → i.e. Website browser communicating with Primis database), and *providing a mechanism for selecting a content entity identifier or a container from the second list or second outline to add to a desired location in the first list through the user interface* (pgs. 7, 9, 12 → the "Add" hyperlink adds the second list or outline to a specified location in the customized textbook, as discussed above).

**Regarding claims 9, 24, 39,** McGraw further teaches the method, system, and a program storage device readable by a machine wherein *a first container in the second outline contains one or more containers* (pgs. 3, 5-12 → "disciplines container" contains "book containers" which further contains "chapter containers" which further contain "section containers," etc.).

**Regarding claims 10, 25, 40,** McGraw teaches a method, system, and a program storage device readable by a machine as explained with respect to claims 6, 7, and 9 above, but does not specifically teach the method, system, and the program storage device readable by a machine:

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➤ wherein adding the first container to the first outline adds the content entities identified by the content entity identifiers of *all containers* in the first container to the first object.

However, McGraw teaches the outlining of textbooks into containers for the purpose of increasing the modularity of files for ease in creating a mixed and matched customized book (pgs. 3, 7, 9, 12).

It was commonly known to those of ordinary skill in the art that in hierarchical outlines each level is subordinate to the one above. Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the teachings of McGraw to add the content entities identified, as well as all of the content entities' dependents (i.e. full containers), in the first container object for the purpose of increasing the modularity of files for ease in creating a mixed and matched customized book.

**Regarding claims 12, 27, 42,** McGraw further teaches the method, system, and a program storage device readable by a machine wherein *the first and second objects are books* (pgs. 6, 8, 10) and the *containers are one or more of a book, volume, and a chapter* (pgs 7, 9, 12).

**Regarding claims 15, 30, 45,** McGraw further teaches a user interface communicating with the data repository, and providing a mechanism for creating a new container to add to the first outline at a desired location through the user interface (pg. 3

→ allows instructors to add their own created syllabus to the first outline at a desired location by uploading it through the user interface).

**Regarding claims 46-48**, McGraw teaches the method, program storage device, and system wherein said first list of content identity identifiers defining the first object comprises content identity identifier names (see pgs. 5-9, and 12 → each content identity is identified by a unique title or name, a unique URL, and a unique Item Identifier number), but does not specifically teach the content identity identifier names being defined by the user.

However, McGraw teaches the compilation of a custom textbook using the instructor's own content and materials (see pgs. 1 and 3 – 2<sup>nd</sup> paragraph) for the purpose of customizing the textbook to the instructor's own personal preferences. It was commonly known to those of ordinary skill in the art that an instructor can define his own work's content entity identifier for the purpose of customizing the final textbook to the instructor's own personal preferences.

Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to allow an instructor to define his own work's content entity identifier for the purpose of customizing the final textbook to the instructor's own personal preferences.

***Response to Arguments***

5. Applicant's arguments filed on 1/17/2006 have been fully considered but they are not persuasive. Applicant's arguments are substantially directed to the amended subject matter. The amended subject matter is addressed above with respect to the discussion of independent claims 1, 6, 16, 21, 31, and 36.

***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Nguyen-Ba whose telephone number is (571) 272-4094. The examiner can normally be reached on 11 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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PNB

3/21/06

*William L. Bashore*  
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PRIMARY EXAMINER  
4/3/2006